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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

051291.81516

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on _____

Signature _____

Typed or printed name _____

Application Number

09368503

Filed

August 5, 1999

First Named Inventor

Larren F. Jones

Art Unit

3641

Examiner

C.J. Novosad

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Charles W. Shifley/

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Charles W. Shifley

Typed or printed name

☒

attorney or agent of record.

Registration number 28,042

312.463.5000

Telephone number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

March 15, 2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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SHEETS ATTACHED TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number 51291.81516

Application Number 09/368,503 Filed 08/05/1999

First Named Inventor Darren F. Jones
Art Unit 3641 Examiner Christopher J. Novosad

1. THE SOLE ISSUE IS THE DECLARATION

There is no issue in this case except an issue of the declaration.

2. THE FINAL OFFICE ACTION HAS REQUIRED IDENTIFICATION OF CLAIM ERRORS IN DETAIL

The final Office Action dated February 25, 2011 has stated that the declaration is defective. The final Office Action has asserted that:

specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors of the original claims. It is to be noted that the error is not recited in terms of what is wrong with the patent claims. It has to be recited as to what the error is with the patent, not what is being done to correct it.

These statements have been repeated for many years in many rejections. The final Office Action cites 37 CFR 1.175 and MPEP 1414 as the support for the rejection.

3. THE DECLARATION IS PROPER

The declaration of this case consists of four declarations – the original Joint Reissue Application Declaration filed 02-01-2000 (see PAIR, date of 02-01-2000, “Oath or Declaration filed”), a first supplemental declaration (05-08-2007), a second supplemental declaration (7-31-2007), and a third supplemental declaration (06-23-2010)(accepted by grant of petition). The “declaration” (in the form of the four identified

declarations) is proper. It meets the legal standard for reissue declarations. *Id.* The declaration satisfies 37 CFR 1.175(A)-(D) and both of MPEP 1414 and 1414.01.

Satisfying 37 CFR 1.175(A), and MPEP 1414 in part, the original declaration states that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of the patentee claiming more or less than the patentee had the right to claim in the patent.

Satisfying 37 CFR 1.175 (B) and MPEP 1414 in further part, the original declaration states at least one error which is relied upon to support the reissue application. In fact, it states several errors. For example, it states:

7. Claims 1 and 51 are each directed to a wear assembly which includes, inter alia, a rigid lock ... The recitation that the lock has a rigid construction is more narrow than we had a right to claim.

Satisfying 37 CFR 1.175(C) and MPEP 1414 in further part, the original declaration states that all errors which are being corrected up to the time of filing of the original declaration arose without any deception on the part of the applicant.

Satisfying 37 CFR 1.175(D) and MPEP 1414 in further part, the original declaration includes the information required by 37 CFR 1.63.

Satisfying MPEP 1414.01, all the supplemental declarations state that every error which was corrected in the reissue application, and not covered by the original declaration, arose without any deceptive intention on the part of the applicant.

4. THE REQUIREMENT OF IDENTIFICATION OF CLAIM ERRORS IN DETAIL IS AN ERROR OF LAW

In contrast to the final Office Action rejection and assertion, the declaration is not defective, and the rejection of the final Office Action as to the declaration is a plain error

of law. In requiring that the applicant here identify “specific changes/amendments to the claims ... in detail in the declaration,” and “in addition to the errors of the original claims,” the final Office Action is committing plain error. There are not such requirements in the law, CFR or MPEP. Indeed, MPEP 1414 specifically states that “having once stated an error ... a subsequent ... declaration ... need not specifically identify any other error or errors being corrected.”

This reissue application was filed in 1999, and the current CFR and MPEP apply. *Shockley v. Arcan, Inc.*, 248 F.3d 1349 (Fed.Cir. 2001). See Applicant Arguments/Remarks Made in an Amendment, pages 12-30 (see PAIR date of July 27, 2009). *Id.* The current CFR and MPEP do not permit the requirement of the Office Action:

To reissue original claims, a patentee must show that the changes will remedy errors that occurred without deceptive intent. 35 U.S.C. § 251 (1994). Section 1.175 of title 37 of the Code of Federal Regulations governs the examination of reissue applications. ... The ... rule, effective December 1, 1997, requires the patentee to disclose only a single error for correction and to include only a general statement that the errors involved no deceptive intent. 37 C.F.R. § 1.175(a) (1997).

Id.

In conclusion, in requiring that the applicant here identify “specific changes/amendments to the claims ... in detail in the declaration,” and “in addition to the errors of the original claims,” the final Office Action is committing an error of law.